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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,734	07/22/2003	Hiroshi Nishikawa	204552029100	6065

25227 7590 09/12/2007

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EXAMINER

JOERGER, KAITLIN S

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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09/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/623,734

Applicant(s)

NISHIKAWA ET AL.

Examiner

Kaitlin S. Joerger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asada et al. (U.S. Patent 5,584,475).

Regarding claim 1, Asada et al. teaches an for transporting sheets into a fixed image reading position, comprising:

a drive roller, 4; and

a pad having a lower layer, 45, made of a flexible material, see column 5, line 49 through column 6, line 24, and an upper layer, 26, provided on the lower layer and made of rigid material in the form of film with a kinetic friction coefficient of 0.2 or less, see column 5, lines 53-56, the pad being biased to the drive roller so that the upper layer contacts a peripheral surface of the drive roller to form a nipping region between the drive roller and the pad by a compressive deformation of the flexible lower layer of the pad, see figures 4 and 6,

wherein the pad is configured within the apparatus so that sheets traveling between the drive roller, 4, and the pad do not come in contact with the flexible material that has a kinetic friction coefficient higher than the rigid material of the upper layer, see figure 6.

Asada et al. does not specifically teach that the kinetic coefficient of friction of the upper layer is .2 or less, however Asada et al. does teach a low coefficient of friction for the upper

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layer, 26. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an upper layer in the apparatus taught by Asada et al. with a coefficient of friction of .02 or less, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 2, Asada et al. teach a flexible lower layer, 45, however Asada et al. does not teach that the lower layer has a compressive residual strain of 10% or less. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a lower layer in the apparatus taught by Asada et al. with a compressive residual strain of 10% or less, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 6, Asada et al. teaches that the pad is biased toward the drive roller by a spring, 40.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asada et al. in view of Nakamura et al.

Regarding claim 3, Asada et al. teaches all the features of the claimed invention except for the feature that the upper layer of the pad is made of an electrically conductive material, but Nakamura et al. does teach this feature. Nakamura et al. teaches a separation pad with an upper layer, 33g, made of an electrically conductive material, see figure 29 and column 8, line 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the

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purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of Asada et al. as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

Regarding claim 4, Asada et al. teaches all the features of the claimed invention except for the feature that the lower layer of the pad is made of an electrically conductive material, but Nakamura et al. does teach this feature. Nakamura et al. teaches a separation pad with a lower layer, 33a, made of an electrically conductive material, see figure 29 and column 8, line 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of Asada et al. as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

Regarding claim 5, Asada et al. teaches all the features of the claimed invention except the feature wherein an electrostatic charge generated by a contact the upper layer with the sheet is discharged through the lower layer, but Nakamura et al. does teach this feature, see column 8, lines 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of Asada et al. as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

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Allowable Subject Matter

Claim 7 is allowed.

Response to Arguments

Applicant's arguments filed 22 June 2007 have been fully considered but they are not persuasive. Applicant argues that because 45 and 5A are made of the same material, and since the sheet is shown to come in contact with the section 5A, then the reference does not teach the added limitation to claim 1. The examiner contends, however, that 45 and 5A are two separate parts, and the sheet never comes into contact with part 45. Therefore, the sheet never comes into contact with the flexible material of part 45, which is what is being claimed in claim 1. Therefore, the Asada et al. reference does anticipate the claim and claim 1 and those that depend therefrom remain rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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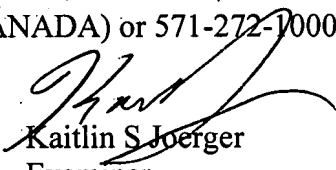
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kaitlin S. Joerger
Examiner
Art Unit 3653

7 September 2007


PATRICK MACKEY
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